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10/612,506	07/02/2003	Motoaki Aoyama	KOT-0078	3507
23413 7590 03/02/2009 CANTOR COLBURN, LLP 20 Church Street 22nd Floor Hartford, CT 06103				
EXAMINER NGUYEN, ALLEN H				
ART UNIT 2625		PAPER NUMBER		
NOTIFICATION DATE 03/02/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

usptopatentmail@cantorcolburn.com

Office Action Summary

Application No.

10/612,506

Applicant(s)

AOYAMA ET AL.

Examiner

Allen H. Nguyen

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2008.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) 16-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-845)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

- This office action is responsive to the following communication:
Amendment filed on 11/26/2008.
- Claims 1-42 are currently pending, with claims 16-42 being withdrawn, in the application.

Response to Arguments

1. Applicant's arguments filed 11/26/2008 have been fully considered but they are not persuasive.
2. With respect to applicant's argument that "Okimoto does not teach or suggest the receiving section of claim 1 that is structured to receive both image data and post processing data.

In reply: Okimoto teaches the receiving section of claim 1 that is structured to receive both image data (column 23, line 16) and processing data (e.g., number of sheet onto which the print data is desired to be printed, column 12., lines 55-60).

Okimoto '926 does not explicitly show said processing data include post processing data, post processing data is defined as such a physical treatment that is to be applied to said print product after said whole image forming process is completed, so as to physically change an appearance and/or a binding mode of said print product.

However, the above-mentioned claimed limitations are well known in the art as evidenced by Harris '717. In particular, Harris '717 teaches said post processing is

defined as such a physical treatment that is to be applied to said print product after said whole image forming process is completed (the user can instruct the digital transmitting device to perform such post-processing as binding, collating, folding, stacking, stapling, stitching, edge-trimming, paginating, and printing on substrates of varied composition; Col. 4, lines 64-67), so as to physically change an appearance and/or a binding mode of said print product (With respect to step 14, the post-processing instructions, if any, are carried out upon the document on the destination device; Col. 5, lines 49-53, fig. 1B).

In view of the above, having the system of Okimoto and then given the well-established teaching of Harris, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the system of Okimoto as taught by Harris to include: said post processing is defined as such a physical treatment that is to be applied to said print product after said whole image forming process is completed, so as to physically change an appearance and/or a binding mode of said print product, since Harris stated in col. 1, lines 5-10, that such a modification would ensure a system providing information regarding the auto-routing transmittal of the document to the desired recipient, and providing information regarding any post-processing of the document.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okimoto et al. (US 6,268,926) in view of Harris (US 6,799,717).

Regarding claim 1, Okimoto '926 discloses an apparatus (4, fig. 3) that receives an electronic mail (i.e., the apparatus that the print mail reception utility 31b is for receiving electronic mail; Col. 9, lines 5-6), and creates a print product based on image data included in said electronic mail (i.e., the print mail reception utility 31b prints the print data included in the file attached to the print mail if needed, and also prints the contents of the ordinary mail, that is, the message included in the ordinary mail and the file attached to the mail; Col. 32, lines 25-65, figs. 22- 23, 26, 28-29), said image forming apparatus comprising:

a receiving section (the mail reception system, col. 5, lines 25-35) to receive said electronic mail including said image data (The computer on the receiving end can directly extract the print data from the mail and then output that data directly to the printer. Therefore, allowing the receiver to directly obtain printed material of the received mail data from the printer; Col. 1, lines 45-55) and processing data representing a processing to be applied to said print product created on the basis of said image data (allowing the user on the receiving end to view the document by the compacting or reducing process is, for example, a process for reducing the size of a print pattern defined by one page's worth of print data so that reduced print patterns defined by more than one pages' worth of print data can be printed onto one sheet of

paper ; Col. 6, lines 60-67), wherein said print product includes a single paper sheet or a plurality of paper sheets (i.e., the number of pages of print data to be printed onto one sheet of paper; Col. 7, lines 1-5), on each of which an image is already formed through a whole image forming process based on said image data (i.e., the print data is described, and the number of sheets, onto which the print data is desired to be printed; Col. 7, lines 60-65),

an acquiring section (Printer Driver 30, fig. 3) to acquire said image data and said processing data (i.e., image data and four pages' worth of data is converted into a one-page layout; Col. 23, lines 15-20), separately from said electronic mail (POP Server 38, fig. 3);

a processing data judging section (Print Mail Reception Utility 31b, fig. 3) to determine whether or not said processing (i.e., the present print mail reception utility process 31b is executed on the computer system 8 side, the process of S984 is executed to, judge whether the printer 6 is set to the page description language, a page description language specifies the arrangement of a printed page through commands from a computer that the printer carries out, as determined in S982; Col. 22, lines 15-20, and fig. 14), represented by said processing data (i.e., it is noted that at least a process for reducing the size of a print pattern defined or data indicating whether the print data included in the attached file is representative of a single color image or a full color image; Col. 6, lines 64-67 and Col. 26, lines 10-15), is provided in said image forming apparatus itself as an applicable post processing (i.e., a print process setting; Col. 11, line 65; Col. 12, lines 15-25);

a determining section (Transmission Command CPU 132, fig. 2b) to determine whether or not said processing data should be changed (i.e., It is noted that when the present print mail reception utility process 31b is executed on the computer system 8 side, the process of S984 is executed to, judge whether the printer 6 is set to the page description language as determined in S982; see col. 22, lines 15-20, fig. 14), when said processing data judging section determines that said processing is not provided in said image forming apparatus itself (NO in S984, fig. 14),

an establishing section (print mail reception utility process, fig. 3) to establish a set of finish-setting items representing post processing (i.e., 4 in- 1 finishing information, fig. 15, S995) to be applied to said print product based on a result made by said determining section (a program of a print mail reception utility 31b shown in FIGS. 8-17).

Okimoto '926 does not explicitly show said post processing is defined as such a physical treatment that is to be applied to said print product after said whole image forming process is completed, so as to physically change an appearance and/or a binding mode of said print product.

However, the above-mentioned claimed limitations are well known in the art as evidenced by Harris '717. In particular, Harris '717 teaches said post processing is defined as such a physical treatment that is to be applied to said print product after said whole image forming process is completed (the user can instruct the digital transmitting device to perform such post-processing as binding, collating, folding, stacking, stapling, stitching, edge-trimming, paginating, and printing on substrates of varied composition;

Col. 4, lines 64-67), so as to physically change an appearance and/or a binding mode of said print product (With respect to step 14, the post-processing instructions, if any, are carried out upon the document on the destination device; Col. 5, lines 49-53, fig. 1B).

In view of the above, having the system of Okimoto and then given the well-established teaching of Harris, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the system of Okimoto as taught by Harris to include: said post processing is defined as such a physical treatment that is to be applied to said print product after said whole image forming process is completed, so as to physically change an appearance and/or a binding mode of said print product, since Harris stated in col. 1, lines 5-10, that such a modification would ensure a system providing information regarding the auto-routing transmittal of the document to the desired recipient, and providing information regarding any post-processing of the document.

Regarding claim 2, Okimoto '926 discloses the apparatus (4, fig. 3), wherein said acquiring section (Printer Driver 30, fig. 3) includes an electronic mail analyzing section (CPU 132, fig. 2b) to analyze said electronic mail so as to acquire said image data (i.e., the print mail transmission utility 31a is executed by the CPU 132 when a print mail transmission instruction is issued from the printer driver 30; Col. 9, lines 1-5) and said processing data (i.e., image data and four pages' worth of data is converted into a one-page layout; Col. 23, lines 15-20), separately from said electronic mail (POP Server 38, fig. 3).

Regarding claim 3, Okimoto '926 discloses the apparatus (4, fig. 3), further comprising: a processing content storing section (RAM 133, fig. 2b) to store a content of post processing provided in advance (a RAM 133 for preparing a storage area for temporarily storing print data to be transmitted to a transfer destination; Col. 8, lines 27-30) in said image forming apparatus itself (4, fig. 3) as applicable processing (a print process setting, col. 11, line 65).

Regarding claim 4, Okimoto '926 discloses the apparatus (4, fig. 3), wherein, when said finishing information judging section (Print Mail Reception Utility 31b, fig. 3) determines that said processing (a print process setting, col. 11, line 65) is provided in said apparatus itself (4, fig. 3), said establishing section (Printer Selecting and Setting Process, fig. 14) establishes said set of setting (S984, fig. 14), according to said processing data directly acquired from said electronic mail (Select the Appropriate Printer for Print Output S987, fig. 14).

Regarding claim 5, Okimoto '926 discloses apparatus (4, fig. 3), wherein said electronic mail analyzing section includes a processing data rule storing section to store a rule with respect to a description of said processing data (i.e., the header 50b of the print mail further includes print information (processing format data) such as an indicative rule of how the print data included in the attached file is desired to be printed at the transfer destination; Col. 7, lines 53-60), and analyzes said electronic mail data

based on a content stored in said information processing data rule storing section to acquire said processing data, when analyzing said electronic mail (i.e., file attributes such as a page description language (emulation), at which the print data is described, and the number of sheets (finishing information), onto which the print data is desired to be printed; Col. 7, lines 62-65).

Regarding claim 6, Okimoto '926 discloses the apparatus (4, fig. 3), wherein said processing data rule storing section stores a tag description (i.e., the process in S982 may be modified to determine whether the mail header includes processing format data indicating that the print data in the attached file is representative of a full color image; see col. 26, lines 10-20) and said processing data while correlating them with each other (i.e., the file attributes as print information, included in the mail header include codes indicative of the page description language; Col. 26, lines 5-7).

Regarding claim 7, Okimoto '926 discloses the apparatus (4, fig. 3), further comprising: a notifying section to notify a sender of said electronic mail (Return to Sender Specified in S630, fig. 11), when said processing data judging section determines that said processing is not provided in said image forming apparatus itself (i.e., if there exists no printer having this function to interpret the page description language as determined in S982 ("no" in S985), then in S988 a message is displayed in the mail log window 52 indicating that the current print mail is unprintable; Col. 22, lines 40-45, and fig. 14, Print Mail is Unprintable S988).

Regarding claim 8, Okimoto '926 discloses the apparatus (4, fig. 3), wherein said notifying section notifies said sender of a fact that said post processing (Return to Sender Specified in S630, fig. 11), represented by said processing data (Printer Selecting and Setting Process, fig. 14), is not provided in said image forming apparatus itself as said applicable processing (Indicate in mail log that print mail is unprintable in S988, fig. 14), and of another applicable processing corresponding thereto (Switch printer setting to appropriate function in S986, fig. 14).

Regarding claim 9, Okimoto '926 discloses the apparatus (4, fig. 3), further comprising: a notifying section to notify a sender of said electronic mail of content (i.e., the program determines in S993, based on the contents of its mail log data (mail header); see col. 22, lines 53-55, fig. 15) of processing applicable in said image forming apparatus itself (i.e., the page description language describing the subject print data is converted in S995 so that print data equivalent to four pages before conversion is reduced to one page of print data; Col. 23, lines 8-10, fig. 15).

Regarding claim 10, Okimoto '926 discloses the apparatus (4, fig. 3), wherein said applicable processing differs depending on a sender of said electronic mail (i.e., the print mail is transmitted to a receiving end (transfer destination) as specifically desired by a sender to be printed at the transfer destination. The cancel

mail is transmitted to the receiving end (transfer destination) of the print mail as instructed by the sender to cancel printing of the print mail; Col. 7, lines 30-35).

Regarding claim 11, Okimoto '926 discloses the apparatus (4, fig. 3), further comprising: an individual-sender processing storing section to store identifying information for an individual-sender and a finishing content, which is allowed for said individual-sender, while correlating them with each other (i.e., the header 50b of the ordinary mail includes: a message ID identifying that mail; an address of a mail server (24 or 28) connected to the sender; an address of the transfer destination; a subject of the mail; and the like; Col. 7, lines 44-49, and fig. 18, Mail Structure).

Regarding claim 12, Okimoto '926 discloses the apparatus (4, fig. 3), further comprising:

a sender rejecting section to stop an image-forming operation based on said image data included in said electronic mail, when an address of a sender coincides with a rejecting address established in advance (i.e., the cancel mail is transmitted by the mail server 24 to the Internet 28, along which the cancel mail is transferred until eventually arriving at the a destination. The computer system at the destination address will attempt to prevent the printing of the print mail indicated by the one or more cancel message IDs included in the cancel mail. The computer system will delete data of the print mail; Col. 14, lines 42-49).

Regarding claim 13, Okimoto '926 discloses the apparatus (4, fig. 3), further comprising:

a sender restricting section to allow an image-forming operation based on said image data included in said electronic mail, only when an address of a sender coincides with an allowed address established in advance (i.e., the header 50b of the ordinary mail includes: a message ID identifying that mail; an address of a mail server (24 or 28) connected to the sender; an address of the transfer destination; a subject of the mail; Col. 7, lines 46-49, and fig. 1).

Regarding claim 14, Okimoto '926 discloses the apparatus (4, fig. 3), further comprising:

an image-forming section to conduct an image-forming operation based on said image data (i.e., the process of S983 may be modified to set a printer, which is capable of interpreting the page description language of the print data and which is capable printing the color-printing type of the print data, to a function mode to interpret the page description language of the print data and to print the print data at the corresponding color-printing type; Col. 26, lines 35-40, and fig. 13).

Regarding claim 15, Okimoto '926 discloses the apparatus, further comprising:

a processing section to apply said post processing to said print product (i.e., the print mail reception utility 31b is for receiving electronic mail addressed to the apparatus 4 and for executing processing operations in correspondence with the contents of the

mail; Col. 9, lines 5-10);

wherein said processing section performs processing (Reduce 4 pages of print data to 1 page in S995) based on said set of setting items (i.e., a print process setting; Col. 11, line 65).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Nakai et al. (US 5,909,602) discloses an electronic RDH set key is displayed on the post-processing setting screen.

Nagashima (US 5,466,328) discloses a post-processing unit connected to a recorded sheet discharge section of an electronic copying machine.

Tamura (US 7,317,545) discloses a staple processing means to perform the stapling process as a post-processing means.

6. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allen H. Nguyen whose telephone number is (571)270-1229. The examiner can normally be reached on 9:00 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, KING Y. POON can be reached on (571) 272-7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/King Y. Poon/
Supervisory Patent Examiner, Art Unit 2625

/Allen H. Nguyen/
Examiner, Art Unit 2625

